

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 96

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JOHANNES G. BEDNORZ  
and  
CARL A. MUELLER

Appeal No. 2001-0809  
Application 08/303,561

ORDER REMANDING TO EXAMINER

**MAILED**

**FEB 22 2002**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

A review of the official record indicates that the following Amendments were approved and have not been physically entered in the official record:

- Amendment N (Paper No. 78, filed June 14, 1999);
- Amendment O (Paper No. 79, filed June 15, 1999);
- Amendment P (Paper No. 80, filed June 15, 1999);
- Amendment S (Paper No. 82-1/2, filed July 11, 1999);
- Amendment T (Paper No. 87, filed Sept. 1, 1999).

37 CFR § 1.122(a) states:

[a]mendments are "entered" by the Office by making the proposed deletions by drawing a line in red ink through

Appeal No. 2001-0809  
Application No. 08/303,561

the word or words cancelled, and by making the proposed substitutions or insertions in red ink, small insertions being written in at the designated place and larger insertions being indicated by reference.

The entry of the Amendments (Paper Nos. 78, 79, 80, 82-1/2, and 87) do not comply with 37 CFR § 1.122(a). Compliance is required.

Applicants have filed a "THIRD SUPPLEMENTAL APPELLANT'S REPLY TO THE EXAMINER'S ANSWER" (Paper No. 95) dated February 5, 2002. The record does not contain a response from the examiner stating whether the "Third Supplemental Appellant's Reply to the Examiner's Answer" has been entered, and if entered, what effect the Reply Brief has on the pending rejections. See Section 1208.03 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Aug. 2001), which states:

The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02.

Accordingly, it is

ORDERED that the application is remanded to the examiner for resolution of the following issues:

Appeal No. 2001-0809  
Application No. 08/303,561

• physical entry of the following amendments in compliance with 37 CFR § 1.122(a):

- Amendment N (Paper No. 78, filed June 14, 1999);
- Amendment O (Paper No. 79, filed June 15, 1999);
- Amendment P (Paper No. 80, filed June 15, 1999);
- Amendment S (Paper No. 82-1/2, filed July 11, 1999);
- Amendment T (Paper No. 87, filed Sept. 1, 1999);

• proper response to the "THIRD SUPPLEMENTAL APPELLANT'S REPLY TO THE EXAMINER'S ANSWER" (Paper No. 95, filed February 5, 2002); and

- for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES



---

CRAIG R. FEINBERG  
Program and Resource Administrator  
(703) 308-9797

CRF:svt

Appeal No. 2001-0809  
Application No. 08/303,561

Daniel P. Morris  
IBM CORPORATION  
Intellectual Property Law Department  
P.O. Box 218  
Yorktown Heights, NY 10598